

REMARKS

Applicant acknowledges receipt of the Office action dated September 20, 2007, and thanks the Examiner for the thorough consideration given the present application.

Claims 1-14, 44-46, and 50-70 are now pending in the above application. Dependent claims 58-70 are added.

By this paper, Applicant hereby cancels claims 33-43 and 47-49 without prejudice or disclaimer to the subject matter contained therein and without conceding or taking any position as to the merits of the claim rejections. Applicant reserves the right to refile cancelled claims 33-43 and 47-49 and contest the rejections thereof in one or more subsequent applications. Applicant has cancelled these claims in an effort to expedite prosecution. By making these claim amendments herein, Applicant does not necessarily agree or acquiesce with each statement in the Office action as to why these claims were rejected. The cancellation of claims 33-43 and 47-49 has rendered moot the rejections thereto.

The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

I. Objection to the Claims

Claims 1 and 44 has been amended to change “the device’s socket” to “the socket for receiving a light bulb”, per the Examiner’s suggestions. Accordingly, Applicant respectfully requests withdrawal of the claim objections.

II. Claim Rejections: 35 U.S.C. § 102

Claims 1, 3, 4, 9-12, 33, 34 and 39-41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Fernandez* (U.S. Patent No. 6,756,893). This rejection is respectfully traversed.

At the outset, Applicant respectfully submits that the amendment to independent claims 1 and 33 has rendered moot the rejections thereto. More specifically, claim 33 (and all dependents therefrom) has been cancelled.

In addition, the amendment to independent claim 1 has also rendered moot the rejections thereto (and claims depending from amended independent claim 1). More

specifically, independent claim 1 has been amended to clarify that the device includes “a base portion removably engageable to an external, existing light socket for receiving electrical power via the external, existing light socket.” Claim 1 has also been amended to clarify that the device includes “a socket for receiving a light bulb and electrically connecting the light bulb to the base portion.” Accordingly, the claimed device may thus receive electrical power via an existing light socket (where that existing light socket is external to and not part of the device itself). The electrical power may be applied from the external, existing light socket (via the device’s base portion) to the light source of the device and to the light bulb within the socket of the device. *Fernandez* does not disclose these features, and, accordingly, cannot anticipate independent claim 1 (or claims 3, 4, 9-12 depending therefrom).

In contrast, *Fernandez* (column 1 line 66 through column 2 line 12) discloses a conventional lamp housing 3 with a primary light source 5, such as an incandescent light bulb for a vehicle headlight, stoplight, turn signal, or back up light. The *Fernandez* bulb 5 is mounted in a socket 4 that is coupled to electric power terminals 2 through the usual operating switches 13 to turn on the light as required to emit the requisite light external to the vehicle. *Fernandez* also discloses LEDs 8 mounted on the socket 4 so as to encircle or surround the primary light source 5. *Fernandez* discloses that the LEDs 8 may be provided as part of a specially constructed socket, or the LEDs 8 may be mounted on an annular base 7 that is adapted as a special circuit 12 to be retrofitted onto an existing socket 4 by drilling a hole for the wires through the socket 4.

This single passing reference in *Fernandez* that the LEDs 8 may be provided as part of a specially constructed socket is not sufficient to support an anticipation rejection of amended claim 1. This is because *Fernandez* provides no detail about this specially constructed socket (notably, it is not identified by any reference number shown in the figures). Indeed, it is unclear from the disclosure of *Fernandez* whether the specially constructed socket would include any of the device features recited in claim 1. For example, it is unclear from *Fernandez* whether that specially constructed socket for the LEDs would also be removably engageable to an external, existing light socket for receiving electrical power for operating the LEDs. It is also unclear whether the

Fernandez specially constructed socket for the LEDs would include a second socket for receiving a light bulb.

In regard to the disclosure in *Fernandez* that the LEDs 8 may be mounted on an annular base 7 that is adapted as a special circuit 12 to be retrofitted onto an existing socket 4 by drilling a hole for the wires through the socket 4 (column 2, lines 9-12), *Fernandez* does not disclose that the annular base 7 is removably engageable to an external, existing light socket for receiving electrical power for operating the LEDs. As shown in Figures 3 through 7, the *Fernandez* base 5 only includes the LEDs 8 without any socket for receiving the primary light source 5. In addition, *Fernandez* also does not contemplate the annular base 7 being removably engageable to an existing, external light socket, and instead teaches away by disclosing the use of wires and drilling a hole through the socket 4.

On page 3, the Office action identifies the light socket 4 and states that the central aperture in the base portion 12 is also a socket in *Fernandez*. Applicant respectfully disagrees. First, *Fernandez* identifies component 12 as being a special circuit to be retrofitted onto the existing socket 4 by drilling a hole through the socket 4. Even assuming *arguendo* that the central hole/opening through the *Fernandez* annular base 7 were broadly construed to be a socket (which it is not), that central hole/opening would still not be a “a socket for receiving a light bulb and electrically connecting the light bulb to the base portion”, as recited in claim 1. The term “socket” is understood in the art to mean something other than a hole in a base.

By way of example, the instant application provides an example of a “socket” at paragraph [0017] of the application as published under United States Patent Application Publication No. US 2006/0146527: “In at least one embodiment, the light socket 13 and the device’s socket 14 are both medium base sockets, and the threaded extension 20 of the base portion 12 is sized to be received with a medium base socket.” Applicant believes that a skilled artisan would understand from the disclosure of the instant application (e.g., paragraph [0017] set forth above, etc.) what is meant by the term “socket” such that it is not equivalent to a mere hole through a base member.

For at least the above reasons, *Fernandez* thus fails to disclose each and every feature recited in claim 1. Claim 1 is therefore submitted as patentable over *Fernandez*.

(and the other cited patents). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1 as being anticipated by *Fernandez*.

Claims 3, 4, and 9-12 ultimately depend from independent claim 1, which Applicant believes to be patentable for at least the reasons stated above. Accordingly, Applicant submits that claims 3, 4, and 9-12 are patentable for at least the same reasons set forth above for claim 1 and at least because of their dependence from allowable independent claim 1. In addition, dependent claims 3, 4, and 9-12 are believed to be further patentably distinguishable over the cited patents of record because the cited patents do not anticipate or make obvious the additional features as required by these claims (in combination with features recited in independent claim 1).

III. Claim Rejections: 35 U.S.C. § 103

A. No *Prima Facie* Case of Obviousness

At the outset, Applicant points out that the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 385 (2007), noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. See, M.P.E.P. 2142. The Federal Circuit has also stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see, M.P.E.P. 2142.

B. Claims 2, 7, 8, 36, and 50-57

Claims 2, 7, 8, 36, and 50-57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fernandez* (U.S. Patent 6,756,893) in view of *Lee* (U.S. Patent 5,121,287). This rejection is respectfully traversed.

Claim 36 has been cancelled hereby.

Claims 2, 7, and 8 ultimately depend from independent claim 1, which Applicant believes to be patentable for at least the reasons stated above. Accordingly, Applicant

submits that claims 2, 7, and 8 are patentable for at least the same reasons set forth above for claim 1 and at least because of their dependence from allowable independent claim 1. In addition, dependent claims 2, 7, and 8 are believed to be further patentably distinguishable over the cited patents of record because the cited patents do not anticipate or make obvious the additional features as required by these claims (in combination with features recited in independent claim 1).

For example, claim 2 further recites that “the socket for receiving a light bulb is a medium base socket” and that “the base portion is engageable with a medium base socket.” The Office action on page 5 states that it would have been obvious “to modify the lighting device of *Fernandez* by providing a medium base socket as taught by Lee for benefit of and advantage of providing a lamp with low vertical profile desired for compactness.” Applicant respectfully disagrees for at least the following reasons.

Fernandez discloses a lighting device for use with an automobile’s external lights. See, for example, *Fernandez* background section and column 2 lines 1-2: “incandescent light bulb for a vehicle headlight, stoplight, turn signal or back up light.” See also the claims of the *Fernandez* patent, all of which recite a primary light source for emitting light external to a vehicle.

Applicant is not aware of any automobiles having an external lighting system with medium base sockets, such as for the headlights, turn signals or blinkers, or brake lights. Therefore, modifying the *Fernandez* lighting device to include a base portion that is engageable with *Lee*’s medium base socket would render the *Fernandez* invention unsatisfactory for its intended purpose, that is, use with automobile’s external lights. See also MPEP § 2143.01, V (The proposed modification cannot render the prior art unsatisfactory for its intended purpose) and MPEP § 2145, X, D (It is improper to combine references where the references teach away from their combination). For at least these additional reasons, the present rejection of claim 2 cannot be sustained because a *prima facie* case of obviousness has not been established. A clear articulation of the reason(s) why the claimed invention recited in claim 2 would have been obvious has not been provided, and the factual findings used in concluding that the features recited in claim 2 are obvious are incorrect.

In regard to claim 50, this claim has been amended to clarify that “the member and at least one LED are removably coupled to the base portion such that the member and the at least one LED are separable from the base portion, to thereby allow the at least one LED to be independently operable from the light bulb and the base portion.” Accordingly, the rejection of claim 50 is moot as *Fernandez* in view of *Lee* does not render obvious amended claim 50.

First, the *Fernandez* LEDs 8 are supported by an annular base 7 having a wired connection, by way of drilling holes through the socket 4 (column 2, lines 11-12). After this wired connection is made, the annular base 7 and LEDs 8 supported thereby would not be removable from the *Fernandez* device. And, there would also be no reason to modify the *Fernandez* lighting device such that its LEDs 8 are removable and separable from the device, to allow the LEDs 8 to be operated independent of the primary light source 5 and socket 4. This is because the function of the *Fernandez* LEDs 8 is as a backup light source upon failure of the primary light source 5 of an automobile external lighting system (e.g., brake light, headlight, and turn signal). Accordingly, removing and separating the *Fernandez* LEDs 8 from the primary light source 5 so as to use the LEDs 8 independent from the primary light source 5 would be contrary to the entire crux and teachings of *Fernandez*.

The instant application at paragraph [0024] also describes an exemplary embodiment in which the device may be removed from the socket to provide a portable light source, for example, for use during a power outage. See also new claim __. *Fernandez* doesn't contemplate a removable device, especially one that is portable and may be carried around.

In addition, the Office action on pages 6-7 states that it would have been obvious “to modify the lighting device of *Fernandez* by providing a medium base threaded socket including as taught by *Lee* for benefit and advantage of providing secured connection and quick and easy disconnection of a light bulb.” Applicant respectfully disagrees. Modifying the *Fernandez* lighting device by providing a medium base threaded socket would render the *Fernandez* invention unsatisfactory for its intended purpose, that is, use with automobile’s external lights. See also MPEP § 2143.01, V (The proposed modification cannot render the prior art unsatisfactory for its intended

purpose) and MPEP § 2145, X, D (It is improper to combine references where the references teach away from their combination).

Accordingly, the present rejection of claim 50 cannot be sustained because a *prima facie* case of obviousness has not been established. A clear articulation of the reason(s) why the claimed invention recited in claim 50 would have been obvious has not been provided, and the factual findings used in concluding that the features recited in claim 50 are obvious are incorrect. Applicants respectfully request reconsideration and withdrawal of the rejections of pending claim 50 (and claims 51-57 depending thererfrom under 35 U.S.C. § 103(a)).

Claims 51-57 ultimately depend from independent claim 50, which Applicant believes to be patentable for at least the reasons stated above. Accordingly, Applicant submits that claims 51-57 are patentable for at least the same reasons set forth above for claim 50 and at least because of their dependence from allowable independent claim 50. In addition, dependent claims 51-57 are believed to be further patentably distinguishable over the cited patents of record because the cited patents do not anticipate or make obvious the additional features as required by these claims (in combination with features recited in independent claim 50).

For example, amended claim 51 further recites “at least one power source compartment for receiving at least one battery therein for applying electrical power to the LED.” As noted in the Office action, *Fernandez* discloses the special circuit 12 that receives electrical power through wires (the wires are shown extending from the special circuit 12 or annular base 7 in *Fernandez* FIG. 1) that were drilled through the existing socket 4. For at least these additional reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 51.

C. Claims 5, 6, 37, 38, and 44-49

Claims 5, 6, 37, 38, and 44-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Fernandez* (U.S. Patent 6,756,893) in view of *Diong* (U.S. Patent 5,349,330). This rejection is respectfully traversed.

Claims 37, 38, and 47-49 have been cancelled hereby.

Claims 5 and 6 ultimately depend from independent claim 1, which Applicant believes to be patentable for at least the reasons stated above. Accordingly, Applicant submits that claims 5 and 6 are patentable for at least the same reasons set forth above for claim 1 and at least because of their dependence from allowable independent claim 1. In addition, dependent claims 5 and 6 are believed to be further patentably distinguishable over the cited patents of record because the cited patents do not anticipate or make obvious the additional features as required by these claims (in combination with features recited in independent claim 1).

For example, claim 5 further recites that “the base portion is adapted to receive therein a power source for supplying back-up power to the light source.” The Office action on page 8 states that it would have been obvious “to modify the lighting device of Fernandez by providing an additional back-up power source - batteries – as taught by Diong et al. ('330) for benefit and advantage a redundant power source promoting high operational reliability.” Applicant respectfully disagrees for at least the following reasons.

Fernandez discloses a lighting device for use with an automobile’s external lights. See, for example, *Fernandez* background section and column 2 lines 1-2: “incandescent light bulb for a vehicle headlight, stoplight, turn signal or back up light.” See also the claims of the *Fernandez* patent, all of which recite a primary light source for emitting light external to a vehicle. Given the space constraints associated with automobile external lighting systems, modifying the *Ferndandez* lighting device to include an additional back-up power source may render the *Fernandez* lighting device too large to fit within the normal enclosures for the automobile lighting systems.

In regard to independent claim 44, the amendments made hereby have rendered moot the rejection to claim 44 (and dependents therefrom). More specifically, independent claim 44 has been amended to clarify that the device includes “a base portion removably engagable to an external, existing light socket for receiving electrical power via the external, existing light socket.” Claim 44 has also been amended to clarify that the device includes “a socket for receiving a light bulb and electrically connecting the light bulb to the base portion.” Accordingly, the claimed device of claim 44 may thus receive electrical power via an existing light socket (where that existing light socket is external to and not part of the device itself). The electrical power may be applied from

the external, existing light socket (via the device's base portion) to the light bulb within the socket of the device. *Fernandez* and *Diong* do not disclose, teach, or suggest at least the above features, and, accordingly, cannot anticipate or render obvious independent claim 44 (or claims 45 and 46 depending therefrom).

Fernandez (column 1 line 66 through column 2 line 12) discloses a conventional lamp housing 3 with a primary light source 5, such as an incandescent light bulb for a vehicle headlight, stoplight, turn signal, or back up light. The *Fernandez* bulb 5 is mounted in a socket 4 that is coupled to electric power terminals 2 through the usual operating switches 13 to turn on the light as required to emit the requisite light external to the vehicle. *Fernandez* also discloses LEDs 8 mounted on the socket 4 so as to encircle or surround the primary light source 5. *Fernandez* discloses that the LEDs 8 may be provided as part of a specially constructed socket, or the LEDs 8 may be mounted on an annular base 7 that is adapted as a special circuit 12 to be retrofitted onto an existing socket 4 by drilling a hole for the wires through the socket 4.

This single passing reference in *Fernandez* that the LEDs 8 may be provided as part of a specially constructed socket is not sufficient to support a rejection of claim 44. This is because *Fernandez* provides no detail about this specially constructed socket (notably, it is not identified by any reference number shown in the figures). Indeed, it is unclear from the disclosure of *Fernandez* whether the specially constructed socket would include any of the device features recited in claim 44. For example, it is unclear from *Fernandez* whether that specially constructed socket for the LEDs would also be removably engageable to an external, existing light socket for receiving electrical power for operating the LEDs. It is also unclear whether the *Fernandez* specially constructed socket for the LEDs would include a second socket for receiving a light bulb.

Fernandez also does not disclose that the annular base 7 is removably engageable to an external, existing light socket for receiving electrical power for operating the LEDs 8. As shown in Figures 3 through 7, the *Fernandez* base 5 only includes the LEDs 8 without any socket for receiving the primary light source 5. And, *Diong* fails to make up for these shortcomings of *Fernandez*.

On page 8, the Office action identifies the light socket 4 and states that the central aperture in the base portion 12 is also a socket in *Fernandez*. Applicant

respectfully disagrees. First, *Fernandez* identifies component 12 as being a special circuit to be retrofitted onto the existing socket 4 by drilling a hole through the socket 4. Even assuming *arguendo* that the central hole/opening through the *Fernandez* annular base 7 were broadly construed to be a socket (which it is not), that central hole/opening would still not be a “a socket for receiving a light bulb and electrically connecting the light bulb to the base portion”, as recited in amended claim 44. The term “socket” is understood in the art to mean something other than a hole in a base.

By way of example, the instant application provides an example of a “socket” at paragraph [0017] of the application as published under United States Patent Application Publication No. US 2006/0146527: “In at least one embodiment, the light socket 13 and the device’s socket 14 are both medium base sockets, and the threaded extension 20 of the base portion 12 is sized to be received with a medium base socket.” Applicant believes that a skilled artisan would understand from the disclosure of the instant application (e.g., paragraph [0017] set forth above, etc.) what is meant by the term “socket” such that it is not equivalent to a mere hole through a base member.

For at least the above reasons, *Fernandez* and *Diong* do not render obvious claim 44. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 44.

In addition, *Fernandez* discloses a lighting device for use with an automobile’s external lights. Given the space constraints associated with automobile external lighting systems, modifying the *Fernandez* lighting device to include an additional back-up power source of *Diong* may render the *Fernandez* lighting device too large to fit within the normal enclosures for the automobile lighting systems.

Claims 45 and 46 depend from independent claim 44, which Applicant believes to be patentable for at least the reasons stated above. Accordingly, Applicant submits that claims 45 and 46 are patentable for at least the same reasons set forth above for claim 44 and at least because of their dependence from allowable independent claim 44. In addition, dependent claims 45 and 46 are believed to be further patentably distinguishable over the cited patents of record because the cited patents do not anticipate or make obvious the additional features as required by these claims (in combination with features recited in independent claim 45).

IV. NEW CLAIMS

Claims 58-70 are supported by the application as originally filed. Accordingly, no new matter is added by the introduction of claims 58-70.

Claims 58-70 each directly or ultimately depend from an independent claim 1, 44, or 50 shown above to be allowable. Accordingly, Applicant respectfully submits that these dependent claims are each in condition for allowance for at least the reasons given above in connection with the independent claims from which they ultimately depend and at least because of their dependence from an allowable independent claim.

In addition, dependent claims 58-70 are believed to be further patentably distinguishable because the cited patents do not disclose, teach or suggest the additional features required by claims 58-70 (in combination with the other features recited in the independent claim from which they depend).

V. CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 726-7502.

Applicant believes that the appropriate fees have been included with this filing. If, however, Applicant owes any additional fee(s), the Commissioner is hereby authorized to charge the fee(s) to Deposit Account No. **08-0750**. In addition, if there is ever any other fee deficiency or overpayment under 37 C.F.R. §1.16 or 1.17 in connection with

this patent application, the Commissioner is hereby authorized to charge such deficiency or overpayment to Deposit Account No. **08-0750**.

Respectfully submitted,

Dated: January 22, 2008

By: /Anthony G. Fussner/

Anthony G. Fussner
U.S.P.T.O. Reg. No. 47,582

HARNESS, DICKEY & PIERCE, P.L.C.
7700 Bonhomme Avenue
Suite 400
St. Louis, Missouri 63105
(314) 726-7500